

trifluoromethylbenzoyl)-isoxazole and ethyl 5,5-diphenylisoxazoline-3-carboxylate for the further prosecution on the merits of claims 1-22.

REMARKS

Reconsideration and withdrawal of the requirement for election of species are respectfully requested in view of the remarks herewith, which place the application into condition for allowance.

Pursuant to the provisions of 37 C.F.R. §§ 1.17(a) and 1.136(a), Applicants petition the Assistant Commissioner to extend the time period for Applicants to respond to the outstanding Office Action by three (3) months, i.e., up to and including September 22, 2003 (as September 20, 2003, was a Saturday). A check for \$930.00 is enclosed with this Amendment. Applicants authorize the Assistant Commissioner to charge any additional fee for consideration of this amendment, or credit any overpayment, to Deposit Account No. 50-0320.

In response to the Requirement for an Election of Species, Applicants elect the combination of the herbicidally active compound 5-cyclopropyl-4- (2-methylsulphonyl-4-trifluoromethylbenzoyl)-isoxazole and the safener ethyl 5,5-diphenylisoxazoline-3-carboxylate. The requirement for this election of species is also respectfully **traversed** since the herbicides claimed in this invention are related to one another both functionally and structurally and may be safened by combination with specific group of functionally similar antidotes. Moreover, the elected species are directed to the same inventive concept which may be simultaneously searched.

It is Applicants' understanding that upon the allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent

form or otherwise include all of the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

Applicants respectfully traverse this Requirement for an Election of Species for the following reasons.

Applicants urge that the Requirement is improper as it does not demonstrate that searching all the inventions constitute an undue burden to the Office and because it is contrary to public policy. The MPEP lists two criteria for a proper Restriction Requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ... even though it includes claims to distinct or independent inventions.” *Id.* Since the Requirement does not indicate that searching would constitute an undue burden, this requirement is not met.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Requirement constitutes an undue burden to Applicants as well as the public and, thus, is against public policy. If followed, the Requirement would require Applicants to file an indeterminable number of patent applications. In addition, under GATT, the period of exclusivity for any patents, which issue from the divisional application, is greatly reduced. Applicants cannot mitigate against this because the Requirement does not identify the number of inventions present. Similarly, the public is inconvenienced, as they will not know whether or not Applicants will file divisional applications to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent applications.


In view of the foregoing, the claims of the present application represent a web of knowledge and continuity of effort that merits examination in a single application. Accordingly, modification or withdrawal of the Species Election Requirement are requested, and an early action on the merits is earnestly solicited.

Accordingly, in view of the foregoing, reconsideration and modification of this Restriction Requirement is requested and an early action on the merits is earnestly solicited.

Respectfully submitted,

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